

## REMARKS/ARGUMENTS

Claims 1-17 and 19-34 are pending. No claims are amended.

In response to the claim amendments submitted in Applicants' prior response, the present Office Action has cited a new reference, U.S. Patent Pub. No. 2004/0204244 (hereinafter "Rathsack"). However, as discussed in more detail below, **Rathsack is not a valid prior art reference under 35 U.S.C. § 103(a)**. Therefore, Applicants request that the pending final Office Action be withdrawn.

### Rejections under 35 U.S.C. § 103

Claims 1-4, 7-13, 15, 17, and 19-34 were rejected under 35 U.S.C. § 103(a) as obvious in view of Wells et al., U.S. Pat. No. 6,488,585 (hereinafter "Wells"), Simon et al., U.S. Patent Pub. No. 2003/0087652 (hereinafter "Simon"), Baldwin, U.S. Pat. No. 6,732,195 (hereinafter "Baldwin"), and Rathsack. Claims 5 and 6 were rejected under 35 U.S.C. § 103(a) as obvious in view of Wells, Simon, Baldwin, Rathsack and Itkis, U.S. Pat. No. 4,856,787 (hereinafter "Itkis"). Claims 14 and 16 were rejected under 35 U.S.C. § 103(a) as obvious in view of Wells, Simon, Baldwin, Rathsack, and Jorasch et al., U.S. 6,379,248 (hereinafter "Jorasch").

These rejections are respectfully traversed. It is respectfully submitted that the pending claims are not obvious over the art relied upon for at least the following reasons.

As set forth in paragraph [0003] of the application as filed (and as reflected in PAIR), this application claims foreign priority under 35 U.S.C. § 119(a) from Australian Application No. 2003 901 552, filed April 3, 2003 in the Australian Patent office and titled "GAMING MACHINE COMMUNICATING SYSTEM." Rathsack was filed on April 8, 2003, which is five days after the foreign priority date of the present application. Since Rathsack was filed after the foreign priority date of the present application, Rathsack is not a valid prior art reference under 35 U.S.C. § 103(a).

Claim 1 defines a communications and data transfer system for gaming establishments having a plurality of gaming machines arranged in a configuration. Claim 1 recites, in part:

wherein said transponder is further operable to: make a prediction regarding performance of at least one new game to replace a current game of said one or more gaming machines, and display the prediction regarding the performance of the at least one new game on said one or more gaming machines, **said performance comprising a ratio of coin-in to a unit of time.**

(Emphasis added).

Each of the independent claims recites certain features similar to those of claim 1. Claims 27 clarifies that the performance comprises “a ratio of coin-in to a unit of time.” Claims 20 and 28 clarify that the prediction is regarding “performance of at least one new wager-based game to replace a current wager-based game of said selected gaming machine.” Claims 24 and 29 clarify that the performance relates to the “financial profitability of the gaming machine.”

As argued in the previous response, the foregoing claim recitations are not taught by Wells, Simon, and Baldwin, considered alone or in combination. The Examiner apparently agrees, because none of these references are cited in the Office Action as disclosing or suggesting the foregoing claim recitations. Instead, the Office Action relies upon Rathsack for the foregoing claim recitations in the rejections of each of the independent claims.

To establish a *prima facie* case of obviousness, it must be shown that the prior art discloses each and every element of the claimed invention. As stated in the M.P.E.P., “[t]o reject a claim. . . Office personnel must articulate the following: (1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference.” (M.P.E.P. §2143A).

Since Rathsack is not a valid reference under 35 U.S.C. § 103(a), claim 1 recites features not disclosed or suggested in any of the cited references filed before the foreign priority date of the present application, considered alone or in combination. Therefore, claim 1 is not obvious in view of the cited references.

As discussed herein, independent claims 20, 24, and 27-29 each recite features related to predicting performance that are similar to those recited in claim 1. Thus, it is respectfully submitted that claims 20, 24, and 27-29 are not obvious for at least the same reasons as claim 1. The dependent claims include, by virtue of their dependency, the features of the independent claims on which they are based and thus are not obvious for at least the same reasons.

Therefore, it is respectfully submitted that the rejections to all pending claims under 35 U.S.C. § 103(a) should be withdrawn.

### **CONCLUSION**

Applicants believe that all pending claims are allowable and respectfully request a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

The Commissioner is hereby authorized to charge any additional fees, including any extension fees, which may be required or credit any overpayment directly to the account of the undersigned, No. 50-4480 (Order No. IGT1P145).

Respectfully submitted,  
Weaver Austin Villeneuve & Sampson LLP

/Roger S. Sampson/

Roger S. Sampson  
Reg. No. 44,314

P.O. Box 70250  
Oakland, CA 94612-0250  
(510) 663-1100